

III. REMARKS

Claims 1-18 are pending in this application. By this amendment, claims 1, 9, 17 and 18 have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. 1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicant respectfully requests entry of this Amendment.

In the Office Action, claims 1-18 are rejected under 35 U.S.C. §112 as allegedly failing to comply with the written description requirement. Claims 1, 3-9, and 11-18 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Stupek et al. (US patent no 5,960,189), hereafter "Stupek." Claims 2 and 10 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Stupek in view of "Y2K Compliance and the Distributed Enterprise" by Gowen et al., hereafter "Gowen."

A. REJECTION OF CLAIM 1-18 UNDER 35 U.S.C. §112

The Office has asserted that claims 1-18 fail to comply with the written description requirement. Applicant has amended claims 1, 9, 17 and 18 to remove "...but not provided concurrently with said known second maintenance items." Applicant asserts that this amendment

complies with the written description requirement. Accordingly, Applicant requests that the rejection be withdrawn.

B. REJECTION OF CLAIMS 1, 3-9, AND 11-18 UNDER 35 U.S.C. §102(b)

With regard to the 35 U.S.C. § 102(b) rejection over Stupek, Applicant asserts that Stupek does not teach each and every feature of the claimed invention. In a recent non-precedential opinion, the Court of Appeals for the Federal Circuit explained that “[a] determination that a claim is anticipated under 35 U.S.C. § 102 involves two analytical steps.” *In re Simpson*, 2003 U.S. App. LEXIS 7278, *7 (Fed. Cir. 2003). The claim language first must be interpreted, and then each element of the claim is compared to a prior art reference. *Id.* Because the Office has erred in both analytical steps, Applicant respectfully requests withdrawal of this rejection.

With respect to independent claims 1, 9, 17 and 18, Applicant respectfully submits that Stupek fails to disclose, *inter alia*, starting in said second host session, a database application having a database of known second maintenance items. The Office equates this feature in the claimed invention with the upgrade database that “...contains information regarding the dependencies between the package and other upgrade objects or packages.” Col. 7, lines 8-10. The Office then removes all meaning from the word “known” in Applicant’s claims by stating that “[m]aintenance items must inherently be known if information regarding them is stored in a database.” Office Action, page 7. Applicant asserts that the Office’s definition of the word “known” that effectively eliminates all meaning from the word is not correct. Thus, Stupek does not teach a database of known second maintenance items because, as admitted by the Office, the

upgrade database entries in Stupek are limited to data regarding each upgrade package. Office Action, page 3, par. 5. The claimed invention, in contrast, includes "...a database application having a database of known second maintenance items including prerequisite items and corequisite items corresponding to each of said known second maintenance items." Claim 1. As such, the known second maintenance items in the database as included in the claimed invention are not limited, as in Stupek, to data respecting a particular upgrade package, but instead the database includes known second maintenance items, whether the known second maintenance items are included in a particular upgrade package or not. For the above reasons, the upgrade database in Stupek is not equivalent to the database that includes known second maintenance items as included in the claimed invention. Accordingly, Applicant requests that the rejection be withdrawn.

With further respect to independent claims 1, 9, 17 and 18, Applicant asserts that Stupek does not teach, *inter alia*, searching said database of known second maintenance items for records matching each of said new third maintenance items that have said prerequisite items and corequisite items. Instead, the passage in Stupek cited by the Office teaches that "...the upgrade advisor then retrieves upgrade information from the upgrade database and performs two types of comparisons: a) whether or not a particular upgrade package corresponds to a resource on the server, and b) whether or not the version number of the upgrade package matches the version number of the corresponding network resource." Col. 4, lines 20-27. As such, the only searching of the upgrade database, if any, that is taught by Stupek involves searching information that is retrieved from the upgrade database to perform the above listed comparisons. Col. 4, lines 20-27. Thus, although the upgrade package database in Stupek contains dependency

information, nowhere does Stupek disclose that the upgrade package is specifically searched for items having dependency information. The Office further refers to the fact that the information on dependencies in Stupek is reported or displayed to the user to infer that a search is made for the information. Col. 4, lines 6-9. However, as stated above, the retrieval of information taught in Stupek is limited to the two comparisons listed above. Furthermore, Stupek only reports or displays records that meet those comparisons, whether or not dependencies are present. Col. 4, lines 20-25. The Office misunderstands Applicant's argument to be "...that since Stupek only searches for dependencies in the isolated occurrence of a package upgrade, and does not provide for a search of known second maintenance items in the absence of an associated package, then a search for 'known second maintenance items' could not occur." Office Action, page 4, par. 6. In contrast, Applicant submits that Stupek does not search for dependencies at all, but only for the factors that indicate the occurrence of a package upgrade independent of the presence or absence of dependencies and displays upgrade information whether or not these dependencies exist. Furthermore, Applicant is not attempting to argue that a search for known second maintenance items could not occur, only that Stupek does not specifically teach that records in the upgrade database are specifically searched for dependency information. In contrast, the claimed invention includes "...searching said database of known second maintenance items for records matching each of said new third maintenance items that have said prerequisite items and corequisite items." As such, the searching as included in the claimed invention is not a retrieval of information that uses some unrelated criteria as a prerequisite to display dependency information, but instead is specifically designed to match new maintenance items to matching database records of known second maintenance items having prerequisite items and corequisite items. For

the above stated reasons, the retrieval of information in Stupek is not equivalent to the searching of the database as included in the claimed invention. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

With still further respect to claims 1, 9, 17 and 18, Stupek does not include adding said corresponding prerequisite items and corequisite items to said first list. Instead, the Office equates the first list of third maintenance items with Stupek's "upgrades to the network resources [that] are provided to a server manager by a distribution medium (not shown) such as a CD-ROM." Col. 3, lines 31-43; Office Action, page 8, par. 2. However, nowhere in Stupek is the initial list of available upgrades added to, only deleted from. Additionally, the passage that the Office cites in support of its assertion does not teach addition of dependencies to Stupek's upgrades to the network resources, but only states, "[t]herefore, the dependency information in the Package database describes not only the dependencies between packages on the CD, but also all dependencies between an upgrade package and any upgrade not available on the CD." Col. 7, lines 29-33. Nowhere, in this passage or elsewhere does Stupek teach that dependent items are added to the initial list of available upgrades. In contrast, the claimed invention includes adding to the "...first list of new third maintenance items..." "...said corresponding prerequisite items and corequisite items." Claim 1. Unlike Stupek, this step expressly adds prerequisite items and corequisite items that have been found in the database search to the original list of new third maintenance items to be installed on the system. Accordingly, Applicant requests that the rejection be withdrawn.

With final respect to independent claims 1, 9, 17 and 18, Stupek does not teach or suggest ordering, receiving, and applying said items on said order list where the order list has items not

received. Instead, Stupek retrieves an upgrade package and installs a job to the target server. Col. 4, lines 45-53. The Office admits that Stupek does not order, receive, and apply an item that was not originally included with the new maintenance items. In contrast, the claimed invention includes "...adding those items not received to an order list" and "...ordering, receiving, and applying said items on said order list." Claim 1. As such, the order list as included in the claimed invention includes items on the first list that have not previously been received by the system. Thus, the ordering step as included in the claimed invention does not simply consist of installing an upgrade in the original list of available upgrades as in Stupek, but rather the ordering step as included in the claimed invention orders, receives, and applies an item that was not previously received. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

Furthermore, with respect to claims 6 and 14, Applicant respectfully submits that Stupek fails to teach a Service Link database application having a database of known second maintenance items including prerequisite items and corequisite items corresponding to each of said known second maintenance items. Instead, as stated by the Office, Stupek teaches a server database. Col. 4, lines 14-16. However, Stupek never discloses that the server database is a Service Link database application. Accordingly, Applicant requests withdrawal of the Office's rejection.

With respect to dependent claims 3-8 and 11-16, Applicant herein incorporates the arguments presented above with respect to independent claims 1, 9, 17 and 18 from which claims 3-8 and 11-16 depend. Furthermore, Applicant submits that all dependant claims are allowable

based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

C. REJECTION OF CLAIMS 6 AND 10 UNDER 35 U.S.C. § 103(a)

In the Office Action, claims 2 and 10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stupck in light of Gowen. Applicant herein incorporates the arguments presented above with respect to independent claims 1 and 9 from which claims 2 and 10 depend. As a result, Applicant respectfully requests withdrawal of this rejection.

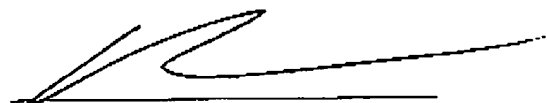
With regard to the Office's other arguments regarding dependent claims, Applicant submits that all dependant claims are allowable based on their own distinct features. However, for brevity, Applicant will forego addressing each of these rejections individually, but reserves their right to do so should it become necessary.

IV. CONCLUSION

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

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